

Arguments/Remarks

Claims 1-20 are pending in the application. It appears from the latest Office Action that the examiner has maintained all of the rejections of record.

I. Rejections of claims 1-20 under Section 112, second paragraph

In response to this rejection, applicants provided a detailed rebuttal in their Response filed on September 8, 2008. In response to those rebuttal arguments, the examiner merely states that "it is maintained that the examples do not delineate the scope for the claimed invention." (Page 2, under heading 3.a) of the Office Action.).

The examiner is reminded that an omnibus rejection of applicant's claims is not only not informative, but should also be avoided (MPEP 707.07(d)). In the present situation, applicants note that while the rejection was maintained, the examiner has failed to provide any information whatsoever regarding how/why applicant's arguments were not persuasive. How then can the issue(s) for Appeal be framed?

In view of the foregoing, applicant reiterates and incorporates herein by reference all of the rebuttal arguments made in their Response filed on September 8, 2008. Should the present rejection be maintained, applicant respectfully requests that the examiner clearly delineate how/why applicants remarks are NOT considered to overcome the current rejection. This information is absolutely necessary so that the issues for Appeal can be accurately framed.

II. The Rejection of Claims 1-7, 10-12 and 13-19 Under 35 U.S.C. § 102(b) over U.S. Patent No. 4,575,434 ("Frank").

Applicant rebuttal arguments made with respect to Frank in the response submitted September 8, 2008 are repeated herein and incorporated herein by reference.

In support of maintaining the present rejection and in response to applicant's arguments, the examiner merely states that "the reference teaches addition of an acid to a solution of amide and nitrile, although it does not expressly disclose the formation of an acid layer." (Page 2, paragraph 3. b) of the Office Action, emphasis ours. In this statement, the examiner clearly acknowledges, on the record, that Frank does not expressly disclose the formation of an acid layer, which is required in the process of the claimed invention. In view of this, it is abundantly clear that the subject rejection, which is made under 35 U.S.C. §102(b)¹, is improper; reconsideration and withdrawal thereof is respectfully requested.

Similarly, should the present rejection be maintained, applicant respectfully requests that the examiner clearly delineate how/why the examiner considers this rejection to be proper. Again, this information is absolutely necessary so that the issues for Appeal can be accurately framed.

III. The Rejection of Claims 8, 9 and 20 under 35 U.S.C. § 103(a) over Frank

Applicant rebuttal arguments made with respect to Frank in the response submitted September 8, 2008 are repeated herein and incorporated herein by reference.

In response to applicant's arguments, the examiner failed to provide **any** rebuttal/comment as to why such arguments were not sufficient to overcome the subject rejection. How then can applicants be expected to formulate a reply and/or to frame the issues for Appeal?

¹ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The examiner is reminded that the examiner has the obligation to consider all rebuttal arguments presented by applicant, and to state why said arguments are insufficient to overcome the final conclusion of obviousness. MPEP 2145. In this case that was not done, and applicants are left wondering why their arguments are insufficient and/or what the issues are for Appeal.

In view of the foregoing, applicants respectfully submit that the present Office Action insufficiently responds to the arguments present by applicant, which renders the subject rejection improper; reconsideration and withdrawal thereof is respectfully requested.

*Additionally, applicant respectfully requests that the examiner discuss this Response and the Office Action mailed December 11, 2008 with the Examiner's Supervisor. In this regard, applicants request that the Office Action mailed December 11, 2008 **be vacated** and that a new Office Action with the time period for responding reset be issued. This new action should clearly articulate not only that applicant's arguments of record are insufficient to overcome the rejections of record (should that be the case), but also **WHY they fail to do so**. The examiner has the obligation to respond to applicant's arguments in detail sufficient for both parties to frame the issues to be appealed. Should the examiner feel that this is not necessary, the examiner is requested to provide the relevant authority in support of the examiner's position so that applicants can weight the merits of a Petition to the Commissioner.*

Should the finality of this case also be maintained, applicant requests that an Appeal Conference be conducted as soon as possible.

In view of the arguments set forth above, Applicant respectfully submits that all of the pending claims are in condition for allowance, which action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'R. J. Mancini', enclosed within a large, loopy oval shape.

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